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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,941	10/26/2001	Charles Eric Cantwell	10013003-1	8423

7590 06/14/2006

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EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,941

Applicant(s)

CANTWELL, CHARLES ERIC

Examiner

Cheukfan Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18 and 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18, 20-30 and 35-39 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-7 and 31 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 8-15, and 32-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-15, 18, and 20-39 are pending. Claims 1, 18, 20-22, 27, 31, and 35 are independent.

2. The indicated allowability of claims 1 and 2 is withdrawn. Rejections based on the newly cited reference(s) follow.

3. The amendment filed March 29, 2006 has overcome the objection to claims 18 and 20 set forth in the previous Office Action dated January 30, 2006.

4. Claims 12-14 are objected because of the following:

In claim 12, line 3, "the alignment device" lacks antecedent basis. Does Applicant intend to have claim 12 depend on claim 5?

Claims 13 and 14 are objected to as being dependent on objected claim 12.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art.

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Regarding claim 1, Applicant's prior art document scanning apparatus (prior art Fig. 2) comprising a base unit (30), an optical scanning device (28), a cover (12), and a document positioning device (document or sheet feeder including rollers 26) configured to move a document with respect to the optical scanning device when the document is positioned between the base unit (30) and the cover (12) (Fig. 2, page 2, lines 12-25 of Applicant's specification).

Applicant's prior art apparatus differs from the claimed invention in that the cover (12) is not freely removable from the base (30).

However, the claimed invention is broadly claimed that it is met by Applicant's prior art apparatus with a broken hinge. A well functioning hinge (14) connecting the cover (12) and the base unit (30) is shown in the prior art Fig. 2. One of ordinary skill in the art would have realized the fact that the hinge does become loose and broken after many uses or after a long period of time, or the hinge just breaks for some reason, and in such a case, the cover (12) becomes freely removable from the base unit (30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to keep the apparatus with a broken hinge and a freely removable cover (12), for scanning a document.

Regarding claim 2, the document positioning device of Applicant's prior art (sheet feeder including rollers 26) comprises a cylindrical powered roller (26).

7. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art and well known art.

Regarding claims 5 and 6, Applicant's prior art Fig. 2 does not show an alignment device comprising a first magnet and a second magnet located in the cover (12) and the base unit (30), respectively. However, the examiner took Official Notice of the fact that such claim feature is notoriously well known in the art in keeping the cover of a scanner, copying machine, etc., stable and aligned with the base unit during an a scanning operation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a first magnet and a second magnet in the cover (12) and the base unit (30) of Applicant's prior art scanner in order to stabilize and align the cover (12) to/with the base unit (30).

Regarding claim 7, the claim recites magnets located adjacent each of the four corners defining the base unit and the four corresponding corners defining the cover. The cover (12) and base unit (30) of Applicant's prior art scanner each have four corners that correspond to those corners of the other. One of ordinary skill in the art would have realized the advantage of employ more than one magnet in each of the cover (12) and base unit (30). The number of magnets would have been a design choice for making the cover and base unit aligned with each other during scanning.

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art and well known art.

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Regarding claim 1, Applicant's prior art document scanning apparatus (prior art Fig. 2) comprising a base unit (30), an optical scanning device (28), a cover (12), and a document positioning device (document or sheet feeder including rollers 26) configured to move a document with respect to the optical scanning device when the document is positioned between the base unit (30) and the cover (12) (Fig. 2, page 2, lines 12-25 of Applicant's specification).

Applicant's prior art apparatus differs from the claimed invention in that the cover (12) is not freely removable from the base (30).

However, the claimed invention is broadly claimed that it is met by Applicant's prior art apparatus with a broken hinge. A well functioning hinge (14) connecting the cover (12) and the base unit (30) is shown in the prior art Fig. 2. One of ordinary skill in the art would have realized the fact that the hinge does become loose and broken after many uses or after a long period of time, or the hinge just breaks for some reason, and in such a case, the cover (12) becomes freely removable from the base unit (30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to keep the apparatus with a broken hinge and a freely removable cover (12), for scanning a document.

With regard to the claimed processor and a plurality of document edge detecting sensors positioned within the base unit, although Applicant's prior art does not discuss such, the examiner took Official Notice of the fact that the processor, the plurality of document edge detecting sensors and their functions as claimed are well known in the

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art of document edge detection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a processor and a plurality of document edge sensors as claimed in order to detect the edges of the document to assist further processing by the processor.

9. Claims 3, 4, 8, 9, 10 11, 15, and 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 12-14 would be allowable if rewritten to overcome the objection(s) set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 18, 20-30, and 35-39 are allowed.

12. The following is an examiner's statement of reasons for allowance:

Claim 3 would be allowable because Applicant's prior art document positioning device (sheet feeder including rollers 26) does not comprise a driven ball as claimed.

Claim 4 depends on claim 3.

Claim 8 would be allowable because the document positioning device (sheet feeder) of Applicant's prior art, along or in combination with other prior art or record,

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does not teach a document positioning device comprising a first driven ball and a second driven ball located at specific ones, respectively, of the corners defining the base unit, as claimed.

Claim 9 depends on claim 8.

Claim 10 would be allowable because, similar to the reason given for claim 3, the roller (26) of Applicant's prior art document positioning device (sheet feeder including rollers 26) is not located in the base unit (30) but is part of or in the cover (12). See Fig. 2. Applicant's prior art further does not include an alignment device comprising an arcuate bearing surface defining a pocket in the cover and configured to receive at least a portion of the powered roller (or roller 26) therein when the cover is aligned on the base unit.

Claim 11 would be allowable because Applicant's prior art, alone or in combination with other prior art of record, does not teach an alignment device comprising a plurality of parallel, spaced apart cylindrical bearings configured to contact the powered roller (or roller) when the cover is aligned on the base unit.

Claim 12 would be allowable because Applicant's prior art Fig. 2 does not show two rollers located adjacent a first side and a second orthogonal side, respectively, the first and second orthogonal sides defining a rectangular platen.

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Claims 13 and 14 depend on claim 12 and would be allowable for the reason given for claim 12.

Claim 15 would be allowable because Applicant's prior art document positioning device (sheet feeder) is not located within the base unit (30) but within or is part of the cover (12).

Reasons of allowance for claims 18 and 20-22 were given in the previous Office Action. The reasons are modified and repeated below.

Claim 18 is allowable over the prior art of record because the prior art, including Leou (5,923,445) does not teach a document positioning program that is configured to cause a processor to actuate a document positioning device when a document edge detector does not detect the edge of a document.

Claims 20 is allowable because the closest prior art Leou (5,923,445) does not teach that the inherently process (see Office Action dated September 22, 2005) to actuate the document positioning device (Fig. 3) to move portions of the document which exceed the platen width and the platen length over the platen. Leou's platen (144) is a large platen (Fig. 2). However, Leou does not disclose moving portions of the document over the platen. Instead, the platen (144) having the large document thereon is moved.

Claim 21 is allowable because the closest prior art Leo (5,923,445) does not disclose that the document positioning device (Fig. 3) selectively moves that document

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in a first direction and in a second direction orthogonal to the first direction. Leou's document positioning device moves the platen only in the two opposite directions.

Claim 22 and its dependent claims 23-36 are allowable because the closest prior art Leou does not disclose automatically moving the document in a first direction so that the second portion of the document is placed over the platen, and optically scanning the second portion of the document by moving the optical scanning device past the second portion of the document, in a method of scanning an oversized document. Leou discloses moving or repositioning the platen (144) having the large document placed thereon.

Claim 27 and its dependent claims 28-30 are allowable because, similar to the reason for allowance given for claim 3, Applicant's prior art does not include a plurality of driven balls in the base unit, as claimed in claim 27.

Claims 32 and 33 would be allowable because Applicant's prior art, alone or in combination with other prior art of record, does not teach that the edge detecting sensors are positioned proximate the edges of the platen, the platen defined by edges and supported by the base unit, as claimed in claim 32, or that the document positioning device comprises an actuator that is actuated by the processor in response to a signal transmitted to the processor by an edge detector sensor.

Claim 34 depends on claim 33.

Claim 35 and its dependent claims 36-39 are allowable because Applicant's prior art does not disclose that the cylindrical powered roller(s) (26 in Fig. 2) are in the base unit (30). Rather, the rollers (26) are in or underneath the cover (12).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
June 5, 2006

A handwritten signature in black ink, appearing to read 'Cheukfan Lee', is positioned to the right of the typed name and date.